

## REMARKS

This application has been reviewed in light of the Office Action dated February 11, 2003. Claims 1-21 are presented for examination, and have been amended to define more clearly what Applicant regards as his invention. Claims 1, 18, and 20 are in independent form. Favorable reconsideration is requested.

Claims 1-21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,069,696 (*McQueen et al.*), in view of U.S. Patent No. 5,416,715 (*Kinoshita et al.*).

As shown above, Applicant has amended independent claims 1, 18, and 20 in terms that more clearly define what he regards as his invention. Applicant submits that these amended independent claims, together with the remaining claims dependent thereon, are patentably distinct from the cited prior art for at least the following reasons.

Recently, color workstations and personal computers have been developed in which a color image reading apparatus utilizing a charge-couple device (CCD), a host apparatus performing color image processing, utilizing computer-aided design (CAD), together with a color printing apparatus have been combined. In such workstations, a multicolor image can be printed. As such, it is now possible that a specific original, one that is prohibited to be copied, such as paper money, securities, or the like, can be forged by reading the original by the color image reading apparatus, temporarily storing the read image, and outputting the read image by the color printing apparatus. The present invention is directed to a color image processing apparatus that executes a forgery determination process.

Among other important feature of the aspect of the present invention that is set forth in independent claim 1, is determining the similarity of a color image and a pattern

of a specific image, where the determination process is independent of a read instruction given by a user to read the color image data stored in image storage means.

*McQueen et al.* relates to automated identification and classification of objects, particularly produce purchased in retail stores. *McQueen et al.* compares color histograms of an object with presorted color histograms associated with known objects (column 15, lines 55-57). However, *McQueen et al.* fails to disclose determination means determining the similarity between the pattern of the specific image and the color image data that is read at a predetermined time independent of a read instruction given by a user to read the color image data stored in the image storage means, as recited in claim 1.

Furthermore, at page 2 of the Office Action, it is specifically conceded that *McQueen et al.* fails to teach that color image data stored in image storage means is read with a predetermined timing.

For at least the above reasons, Applicant submits that claim 1 is clearly allowable over *McQueen et al.*, taken alone (from the Office Action, it is Applicant's understanding that the Examiner agrees with this point).

*Kinoshita et al.*, however, is not seen to remedy the deficiencies of *McQueen et al.* as prior art against claim 1. *Kinoshita et al.* relates to CNC machine tools, industrial robots and graphic systems, and more particularly to an apparatus that graphically checks the spatial interference between a workpiece and a tool, during machining. In *Kinoshita et al.*, a P/S converter outputs red and blue pixels at various times (column 5, lines 16-23). However, nothing has been found in *Kinoshita et al.* that would teach or suggest determination means determining the similarity between the pattern of the specific image and the color image data that is read at a predetermined time independent of

a read instruction given by a user to read the color image data stored in the image storage means, as recited in claim 1.

Further, Applicant submits that a *prima facie* case of obviousness has not been made. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references when combined must teach or suggest all the claimed limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure (M.P.E.P. § 2143). Applicant submits that there is no suggestion or motivation in the references themselves to combine the reference teachings, nor within the knowledge generally available to one of ordinary skill in the art. Further, nothing has been found in the prior art to suggest a reasonable expectation of success in combining *McQueen et al.* and *Kinoshita et al.*

The Office Action on page 2 states that *McQueen et al.* and *Kinoshita et al.* are in the same field of endeavor. In order for the Examiner to rely on a reference as a basis for rejection, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor is concerned (M.P.E.P. § 2141.01(a)). *McQueen et al.*, as noted previously, relates to automated identification and classification of objects, particularly produce purchased in retail stores. *Kinoshita et al.*, on the other hand, appears to relate to CNC machine tools, industrial robots and graphic systems, and more particularly to an apparatus for graphically checking for spatial interference between a workpiece and a tool or the like during

machining. Accordingly, Applicant submits that the references relied upon by the Examiner are not in the field of endeavor of the present invention, and that a person having ordinary skill in the art would not reasonably have expected to solve the problem of preventing forgery of specific originals. For at least these reasons, Applicant submits that a prima facie case of obviousness has not been established.

Accordingly, claim 1 is deemed to be clearly allowable over *McQueen et al.* and *Kinoshita et al.*, taken separately or in any possible combination.

Independent claims 18 and 20 are method and storage medium claims, respectively, corresponding to apparatus claim 1, and are believed to be patentable for at least the same reasons as discussed above in connection with claim 1.

The other claims in this application are each dependent from one or another of the independent claims discussed above and are therefore believed patentable for the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

In view of the foregoing amendments and remarks, Applicant respectfully requests favorable reconsideration and early passage to issue of the present application.

Applicant's undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,

  
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